

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/615,705  
ATTORNEY DOCKET NO. Q60098

to file a divisional application with respect to the non-elected claims. Therefore, Applicant is not required to cancel claim 13 at this time.

2. Claims 3, 8, 9, 10 and 12 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

As argued previously, the rejection of claims 3, 8, 9, 10 and 12 is improper.<sup>1</sup> Claims 3, 8, 9, 10 and 12 are multiple dependent claims that depend from claims 1 and 2. Claim 1 was elected for prosecution on the merits and has been indicated as generic by the Applicant in the Response to Election of Species Requirement filed on March 21, 2001. The claims are not rendered indefinite because they depend from both elected and non-elected species. If claim 1 is allowed as a generic claim then the species defined by claim 2 should also be allowed. Therefore, it is unnecessary to consider the metes and bounds of claims 3, 8, 9, 10 and 12 with respect to claim 2 at this time. Claim 2 has been withdrawn from consideration at this time pending examination of generic claim 1. Therefore, the form of claims 3, 8, 9, 10 and 12 depending from non-elected species claim 2 should simply be considered as withdrawn claims. At present, no burden has been placed on Applicant to file a divisional application with respect to the non-elected claims. Again, Applicant requests that the Examiner withdraw the § 112 rejection.

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<sup>1</sup> For the sake of completeness, Applicant notes that the Examiner failed to include claim 9 in the remarks concerning the 35 U.S.C. § 112, second paragraph rejection of claims 3, 8, 9, 10 and 12.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/615,705  
ATTORNEY DOCKET NO. Q60098

3. Claims 1, 3, 8, 10, 12, 21-23 and 25-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya (JP Heisei 11-154733). Applicant traverses the rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32 for at least the reasons set forth below.

Applicant has overcome the Examiner's previous arguments with respect to Ozaki et al. (U.S. Patent No. 4,456,939), Miller (U.S. Patent No. 5,255,146), Cohn et al. (U.S. Patent No. 5,535,134), Puar (U.S. Patent No. 4,786,956) and Igarashi (U.S. Patent No. 4,656,491).

Furuya discloses, *inter alia*, a capacitor (613) coupled between a  $V_{DD}$  wire (605) and a  $V_{SS}$  wire (604). A MOS device (609) is connected in parallel with the capacitor (613). See Figure 6 of Furuya.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

1. The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).
2. The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
3. The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d

1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

Furuya fails to teach or suggest that the wire resistance of a ground wire portion between an electrostatic protection element and a ground terminal is larger than a wire resistance of the ground wire portion between the electrostatic protection element and a MOS capacitor, as recited in independent claims 1 and 21. In Figure 6 of Furuya, there is no indication that the MOS device (609) is positioned relative to a capacitor (613) such that the resistive relationship as recited in claim 1 is taught or suggested. The Examiner simply states that Figure 6 of Furuya shows the claimed resistive relationship, without any further support as to how one of skill in the art would derive that

teaching from Miller. The Examiner has not pointed to any teaching or suggestion in Furuya that would teach or suggest the claimed resistance relationship between an electrostatic protection device and a capacitor recited in independent claims 1 and 21. Therefore, Furuya fails to show the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in independent claims 1 and 21.

Moreover, the figures of Furuya do not support an obviousness rejection. “When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value.” MPEP § 2125. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” MPEP § 2125 *quoting Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956 (Fed. Cir. 2000). In the instant application, the Examiner persists in making the argument that “...wire resistance is directly proportional to the length of the wire...” In Furuya, the Examiner is obviously relying on the drawings as allegedly supplying the necessary teaching for the claimed resistive relationship. However, the Examiner has not pointed to any teaching or suggestion in Furuya regarding the distances between component connections illustrated in the figures of Furuya. Thus, since the Examiner is not entitled to rely upon the figures in Furuya to provide any teaching with respect to the resistive relationship between the recited elements, the teaching or suggesting all the limitations prong of a *prima facie* case of obviousness has not been satisfied.

Furthermore, it is plainly evident that the Examiner is relying upon the Abstract and a single figure in Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-

32, without considering the teachings of the underlying scientific document. “Citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art.” MPEP § 706.02 (citing *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd. Pat. App. & Inter. 2001) (unpublished)). It is incumbent upon the Examiner to obtain a translation of Furuya so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. See MPEP § 706.02. The record is also not clear whether the Examiner is relying only upon the abstract for Furuya or other text in the disclosure of Furuya to support the 35 U.S.C. § 103(a) rejection of claims 1, 3, 8, 10, 12, 21-23 and 25-32. MPEP § 706.02 states in unambiguous language that the full text document might “include teachings away from the invention that will preclude an obviousness rejection under 35 U.S.C. 103, when the abstract alone appears to support the rejection.” The Examiner cannot simply use the abstract and one figure of Furuya to reject claims 1, 3, 8, 10, 12, 21-23 and 25-32 without first making a determination that the disclosure of Furuya does not teach away from the claimed invention.

MPEP § 706.02 further states that in “limited circumstances, it may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document.” However, the Examiner has made no showing of such “limited circumstances” in the March 19, 2003 Office Action, and therefore is not entitled to use only the abstract of Furuya to reject claims 1, 3, 8, 10, 12, 21-23 and 25-32.

Thus, since the Examiner is improperly relying on the abstract and a single figure of Furuya to reject the claimed resistive relationship between the recited elements, Applicant believes that the

“all the limitations” prong of a *prima facie* case of obviousness has not been satisfied. Applicant believes that independent claims 1 and 21 are allowable over Furuya, and Applicant further believes that claims 3, 8, 10, 12, 22, 23 and 25-32 are allowable as well, at least by virtue of their dependency from claims 1 and 21, respectively.

4. Claims 9 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuya in view of Merritt (U.S. Patent No. 4,786,956). Applicant traverses the rejection of claims 9 and 24 for at least the reasons set forth below.

The Examiner combines Merritt with Furuya in an attempt to overcome the deficiencies of Furuya with respect to the power source conversion circuit recited in claims 9 and 24. Claim 9 includes all the recitations of claim 9 by virtue of its dependency, and claim 24 includes all the recitations of claim 21 by virtue of its dependency.

The Examiner has failed to cite any passage in Merritt that teaches or suggests the claimed resistance relationship between an electrostatic protection device and a capacitor, as recited in independent claims 1 and 21, and included in claims 9 and 24 via dependency. For the same reasons as discussed above with respect to claims 1, 3, 8, 10, 12, 21-23 and 25-32, the combination of Furuya and Merritt fails to teach or suggest the claimed resistive relationship. Applicant believes that the “all limitations” prong of a *prima facie* case of obviousness has not been satisfied, as required by *Vaeck*.

Applicant submits that the Examiner has failed to make a *prima facie* case of obviousness as required by *Piasecki*. The Examiner has not made any findings on the record, as required by

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*Dembiczak*, as to why one of ordinary skill in the art would be motivated to combine Furuya and Merritt, especially when Merritt lacks any teaching whatsoever with respect to the claimed resistive relationship. Applicant believes that the motivation prong of a *prima facie* case of obviousness has not been satisfied.

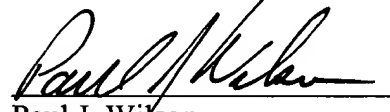
Thus, since the combination of Furuya and Merritt fail to meet the “all limitations” and motivation prongs of *prima facie* case of obviousness, Applicant believes that claims 9 and 24 are allowable over the combination of Furuya and Merritt.

RESPONSE UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 09/615,705  
ATTORNEY DOCKET NO. Q60098

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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